

Appendix A2: Changes to claims (redline)(Version With Markings to Show Changes Made).

Please enter the changes reflected in Appendices A1 and A2.

REMARKS

Reconsideration of the rejections is respectfully requested.

The status of the claims is as follows:

Amended:	62
Pending:	43-74

The claims have been amended to more clearly define the invention. Support for the amendments is apparent, and no new matter is added.

While the Applicant respectfully but strenuously traverses the rejections remaining in the application, the Examiner's thoughtful consideration of the application and help in narrowing the issues for consideration is gratefully noted.

Maintenance of Rejection For Asserted Want of Descriptive Support

The Office Action maintains a rejection asserting that the "third bridge" recitation in paragraph (2) of claim 43 was not described in the application so as to satisfy 35 U.S.C. §112, first paragraph. The Office Action later suggests that the asserted defect is that the immediate predecessor application lacks such description, and Applicant respectfully submits that, though in error as discussed below, such is in fact the relevant asserted defect. Applicant respectfully traverses.

The description requirement of 35 U.S.C. §112 is imposed to assure that a patent application *reasonably* conveys to one of ordinary skill in the art that the inventors had possession of a claimed invention at the time of the filing date relied upon. Ralson Purina Co. v. Far-Mar Co., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). To provide this assurance, the specification must reasonably convey to one skilled in the art the subject matter of the claim. A strong theme of the precedent is that the invention need only be reasonably

described. A recognized need for flexibility is exemplified in MPEP §2163.02, which states that the claims need not be set forth using the same terms (*in haec verba*) used in the specification. Further confirmation that the rule is flexible, and only intended to guard against an inventor claiming what he or she had not yet invented, is found in case law precedent that sets forth that it can be sufficient for drawings alone to provide the written description. See, e.g., In re Wolfensperger, 302 F.2d 950, 133 USPQ 537 (CCPA 1962); Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 19 USPQ2d 1111 (Fed.Cir. 1991); Wang Laboratories v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed.Cir. 1993).

For example, one issue in In re Wolfensperger, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) was whether a drawing showing a relative dimension of an O-ring would support a claim limitation reciting that this relative dimension was for the "untensioned" state, even though there was no express description that the illustrated O-ring was in the untensioned state. The Court looked to practical considerations to find the "untensioned" state to be described in this drawing. A further indication of the practical flexibility of the description requirement is that it does not even appear to have been disputed that the drawing *described* the O-ring as having a "mean diameter corresponding approximately to the mean diameter of said chamber."

The practical flexibility of the description requirement extends to allowing the invention to be claimed in words that set forth the concepts found in an application, even though those specific words are not found in the specification. MPEP §2163.02. For instance, in In re Wright, 866 F.2d 422, 9 USPQ2d 1649 (Fed.Cir. 1989), the Court considered whether the phrase "not permanently fixed thereto," which related to photosensitive microcapsules used in a method of forming images, was adequately supported by a specification that did not use these particular words. The court found that the claim limitation was supported. Wright at 425, 9 USPQ2d at 1651. The Court of Customs and Patent Appeals in In re Anderson stated the general rule as follows:

The question, as we view it, is not whether "carrying" was a word *used* in the specification as filed but whether there is *support* in the specification for employment of the term in a claim; is the concept of carrying present in the original disclosure?

471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973)(emphasis in the original).

Board of Appeals precedent also recognizes this flexibility. For example, in Ex Parte Parks, the *concept* of the negative limitation “in the absence of a catalyst” was seen as adequately conveyed by the examples in which no catalyst was used. Ex Parte Parks, 30 USPQ2d 1234, 1236 (BPAI 1993). In Ex Parte Sorenson, the board found that those of skill would have recognized that “imines” was intended where “amines” was used. Ex Parte Sorenson, 3 USPQ2d 1462, 1463 (BPAI 1987).

The Office Action cites Tronzo v. Bimet, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998) as supporting the proposition that a species does not provide written description to a generic claim. Applicant respectfully submits that nothing so formulaic could be consistent with the repeated teachings of the bodies providing precedent for patent prosecution, which flexible teachings are outlined above. The cited case in question, copy attached, in fact has no such holding. The case holds in essence that a shape of item b cannot be used as support for the claimed shape of item a. The case also holds that a description of the prior art does not teach what is claimed.

Now, let us examine the facts at hand. The application as filed described a genus asserted by the description to (and believed to) encompass the invention. Also disclosed as in the invention was compound A15 that has the bridging structure in question. One of skill looking to these facts would look to how compound A15 fit within the genus. Such a person of skill would see that the “second” bridge of (2ⁱⁱⁱ)(d)(i.) can be (C1-C2) alkyl that *can be independently substituted with (C1-C6) alkyl*, matching the bridge found in compound A15. To ease concerns for the Office, that recitation has been limited to the exemplified third bridge. One reading the priority application would, it is respectfully submitted, understand that the inventors possessed that which is now claimed. Accordingly, Applicant respectfully submits that the rejection should be withdrawn.

Priority

The Examiner objected to the specification, alleging that the continuing data recited in the first line of the specification listed the serial number of a converted non-provisional application.

Applicants submit that their previous response (submitted June 19, 2002) included amendment the first line of the specification, which amendment obviates the objection to the description. Withdrawal of the objection is respectfully requested.

Claim Rejections - 35 U.S.C. §112, Second Paragraph

Claims 43-45, 48, 50-65 and 68-73 stood rejected under 35 U.S.C. §112, second paragraph, based on an assertion that certain terms in the claim rendered the claims insufficient to particularly point out and distinctly claim the subject matter that the applicant regards as the invention.

In particular, the Examiner alleged that the reference to paragraph (2ⁱⁱⁱ)(b)(i) was erroneous.

Applicants submit that their previous response (submitted June 19, 2002) included amendment of claim 43, and, in particular, reference to the disputed paragraph. The previous amendment obviates the instant rejection. Reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner further rejected claim 62, as allegedly being vague and indefinite. Without conceding the correctness of the rejection, Applicants have amended claim 62 to more particularly and distinctly claim the subject matter which Applicants regard as their invention. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim Rejections - 35 U.S.C. §102(b)

Claims 43-74 stand rejected under 35 U.S.C. §102(b), based on assertion that the claims were anticipated by Ognyanov et al., WO 97/45115. The Examiner alleged that the claims of the instant invention were entitled only to the benefit of the filing date of the instant application (i.e., January 9, 2001).

Applicants respectfully disagree. As discussed above, Applicants assert that the predecessor application *reasonably* conveys to one of ordinary skill in the art that the inventors had possession of the claimed invention at the time of the filing date relied upon (i.e., prior to the publication of WO 97/45115). Noting this assertion, Applicants respectfully submit the basis for

the rejection under 35 U.S.C. §102(b) is therefore vacated. Reconsideration and withdrawal of the rejection is respectfully requested.

Conclusion

In light of the above discussion and amendments, it is respectfully submitted that the claims are in condition for allowance. The issuance of a Notice of Allowance is earnestly solicited.²

Respectfully submitted,



Arthur E. Jackson
Registration No. 34,354

Date: February 10, 2003



Princeton Pike Corporate Center
PO Box 5218
Princeton, New Jersey 08543-5218
Allen Bloom (609) 620-3214
Arthur E. Jackson (609) 620-3254
Fax: (609) 620-3259
Attention: Arthur E. Jackson

² FEE DEFICIENCY

IF ANY ADDITIONAL EXTENSION IS REQUIRED, PLEASE CONSIDER THIS PAPER A PETITION FOR SUCH AN EXTENSION; ANY FEE FOR THE EXTENSION REQUIRED FOR CONSIDERATION OF THIS PAPER BUT NOT ENUMERATED ABOVE OR IN A TRANSMITTAL OR OTHER ASSOCIATED PAPER CAN BE CHARGED TO ACCOUNT NO. 04-0480.

AND/OR

IF ANY ADDITIONAL FEE IS REQUIRED FOR CONSIDERATION OF THIS PAPER, PLEASE CHARGE ACCOUNT NO. 04-0480.